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Filomena Zeoli

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466 7590 12/23/2008

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EXAMINER

KOHARSKI, CHRISTOPHER

ART UNIT

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3763

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DELIVERY MODE

12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges the reply filed 12/05/2007 in which claims 1-20 were cancelled and new claims 21-26 were added. Currently claims 21-26 are pending for examination in this application.

### ***Specification***

The abstract of the disclosure is objected to because it exceeds the 150 word maximum limit. Correction is required. See MPEP § 608.01(b).

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “reservoir with a marking thereon” (claim 23) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21-23 and 26 are rejected under 35 U.S.C 103(a) as being unpatentable over Toft et al. (USPN5,407,436) in view of Caralt Batlle (USPN5,114,410).

Regarding claims 21-23 and 26, Toft et al. discloses a syringe (1, Figure 1) with a retractable needle (15), comprising a reservoir (near 9) having an open rear end (near 45), a piston element (7) slidably inserted in said rear end, the piston having an end facing toward the inside of the reservoir, the reservoir having a front end open (near 11)

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and surrounded by a lip (25), a needle carrier (29) carrying said needle and slidable in said lip toward and away from said piston, a spring (33) within the lip continuously urging the needle carrier toward the piston, an inwardly extending shoulder on the lip (25), an inwardly extending shoulder (distal end of 29) on the needle carrier, and a flexible element (35, 37) capable of being secured to and capable of moving with the needle carrier (29), said flexible element having portions (39) that engage with said shoulder on the lip when the spring (33) urges the needle carrier (29) toward the piston (7) thereby to limit movement of the needle carrier toward the piston, the spring (33) can press the needle carrier and the needle and the deformable element in a direction toward the piston thereby to retract the needle within the lip (Figure 1, cols 5-6).

Toft et al. meets the claim limitations as described above except for the hooks for grasping the needle carrier element.

However, Caralt Batlle teaches a disposable hypodermic syringe.

Regarding claims 21-23 and 26, Caralt Batlle teaches a syringe (Figure 1) with a flexible element (14) having hooks (16) thereon that, when pressed into a needle carrier (18), engage beneath the shoulder on the needle carrier (18) to retain the flexible element (14) in a deformed position in which the needle carrier (18) is deformed out of contact with the shoulder on the lip (7), and wherein said flexible element (14) having a member thereon engageable by the piston (14) to press a portion of the flexible element into the needle carrier, when the piston is retracted in a direction away from the needle (3) (Figure 1).

At the time of the invention, it would have been obvious to add the hook elements of Caralt Batlle to the syringe needle of Toft et al. in order to provide attachment between the flexible member and needle carrier to ensure that the needle retracts. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Caralt Batlle (cols 1-2).

***Allowable Subject Matter***

Claims 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to claims 21-26 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 5:30am to 2:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 12/17/2008

/Christopher D Koharski/  
Examiner, Art Unit 3763

/Nicholas D Lucchesi/

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Supervisory Patent Examiner, Art Unit 3763